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TRADEMARK OFFICE

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	: 09/980,126	Confirmation No.	: 8206
Applicant	: YUICHI TAKEGAWA		
Filed	: November 30, 2001		
TC/A.U.	: 1631		
Examiner	: Cheyne D. LY		
Docket No.	: 381NP/50668		
Customer No.	: 23911		
Title	: METHOD AND SYSTEM FOR ACCEPTING COMMISSIONED PRODUCTION OF DNA CHIPS		

Mail Stop NON-FEE AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY

Sir:

The communication responds to the restriction requirement set forth in the Office Action dated March 19, 2004. For examination purposes, applicant elects, with traverse, Group I (claims 13-16 and 21) for prosecution. Further, applicant elects species "a" for examination purposes.

The Office Action required restriction between Claims 13-16 and 21 (I); Claims 17-20 (II); and Claims 22-24 (III). For the reasons detailed below, applicants respectfully request that the restriction requirement be withdrawn, and all pending claims be considered on the merits.

As an initial matter, for two claims to be properly restricted, they must be (1) independent and distinct, and (2) pose a serious burden on the Examiner. See 35 U.S.C. § 121, and 37 C.F.R. § 1.141. See also MPEP §803.

Applicant respectfully submits that the alleged groups of claims are neither independent, nor distinct of one another. Therefore, even under the curious interpretation by the PTO that the phrase "independent and distinct" in 35 U.S.C. §121 means "independent or distinct," the restriction requirement is improper and should be withdrawn.

According to the MPEP, the term "independent inventions" has the same meaning as "unrelated inventions," and "[t]he term "independent" (i.e. not dependent) means that there is no disclosed relationship between the two or more disclosed subjects disclosed, that is, they are unconnected in design, operation, or effect . . . ." MPEP §802.01.

The subject matter in the claims of the three alleged groups all relate to method or systems for accepting orders for the production of DNA chips. In fact, as indicated by the Office Action, all three "groups" of invention are classified in the same class and subclass. Thus, there is absolutely no basis to assert that these claims are unrelated, as the term is used in this context. Therefore, the two alleged groups of claims are not "independent."

The Office Action merely conclusorily state that the "groups" are distinct inventions because they belong to "different chemical types or methods," by reciting the so-called "critical features" of each group of claims, and asserting that there would be undue burden of search. These assertions are not supported by any reason or analysis.

Furthermore, it is well established that burden alone is not a sufficient basis for imposing a restriction requirement. See MPEP § 803. In any event, the Office Action again fails to explain why additional search is needed, or such additional search amount to "unreasonable burden" on the Office, especially in view of the fact the groups have the identical classifications.

In view of the above, applicants respectfully submit that the restriction requirement is improper and should be withdrawn, and request all pending claims be examined on the merits.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (CAM #056207.50668US).

Respectfully submitted,

April 19, 2004

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